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OFFICE OF PETITIONS

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In re Application of

Hayes et al.

Application No. 09/876,563

Filed: June 7, 2001

Attorney Docket No. 12587-007001

DECISION DISMISSING PETITION

UNDER 37 CFR 1.182

This is in response to the "Petition under 37 CFR 1.182" to consider applicants previous "Request to Rescind Previous Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(ii) filed on August 2, 2002", to be the notice of a subsequent foreign or International filing. The previously submitted "Request to Rescind" is not present in the file and two telephone calls were made to Mr. Frank Occhiuti in June to request information concerning that request. The copy of the previously submitted request submitted on May 27, 2003 is the only "Request to Rescind" in the application file.

The petition is Dismissed.

The petition includes a copy of the "Request to Rescind Previous Nonpublication Request," PTO/SB/36 (11-00), signed May 30, 2002 (previously submitted by petitioner), and blank copy of a "Request to Rescind Previous Nonpublication Request," PTO/SB/36 (10-01). Petitioner states that 35 U.S.C. § 122(b)(2)(B)(iii) does not specify a format in which the notice must be given, and that by filing of the rescission notice, applicant provided "*de facto*" notice that one or more foreign or international filings have occurred or would be occurring." Petitioner then contends that the statutory requirement should be met by many forms of notice. Petitioner argues that the request to rescind should be treated as a notification of foreign filing. Petitioner argues that language added to the USPTO form for a Request to Rescind was already implicit in the previous version of the USPTO form, and that "the filing of a Request to Rescind is a tacit notice to the Director that the subject application is being filed internationally and/or in one or more foreign states." Furthermore, petitioner argues that since the only difference between the updated Request form and the original is that the updated Request describes the consequences of its filing in the Note that each form should be treated the same. Petitioner further argues that both versions of the form accomplish the same goal, which is subjecting the application to publication.

35 U.S.C. § 122(b)(2)(B) states:

- (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
- (ii) An applicant may rescind a request made under clause (i) at any time.
- (iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to

provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

37 CFR 1.213 implements the provisions of 35 U.S.C. § 122(b)(2)(B).

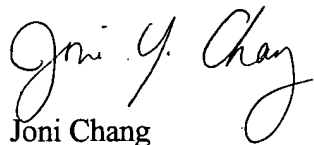
Most patent applications filed on or after November 29, 2000 will be published, unless applicant files a request for nonpublication in compliance with 37 CFR 1.213(a). A nonpublication request is required to contain a certification that "the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement that requires publication at eighteen months after filing." Applicants who do not plan to file in another country are not required to file such a certification, and given that provisional rights (see 35 U.S.C. § 154(d)) may be available to those who have their patent applications published, some applicants who do not plan to file in another country may elect to have their application published to be eligible for provisional rights. As a result, the filing of a rescission of a nonpublication request does not imply that the invention has been or will be filed in another country, and instead suggests that applicant now desires to have the application published in the United States.

Furthermore, 35 U.S.C. § 122(b)(2)(B)(ii) addresses rescission. If all rescissions provided notice of foreign filing, then 35 U.S.C. § 122(b)(2)(B)(iii), which requires applicants to provide notice of foreign filing within a set time period, would have provided that the "rescission specified in clause (ii) must be filed no later than 45 days after the date of foreign filing." Instead, clause (iii) merely specified that an "applicant who has made a request under clause (i)...shall notify the Director of such filing no later than 45 days after the date of such filing" and does not itself require such an applicant to rescind the nonpublication request. Implicit in providing notice of foreign filing is a rescission of the nonpublication request, but not *vice versa*. Thus the statute clearly identifies rescission of a nonpublication request and notification of a foreign filing as two separate acts, and a rescission in and of itself cannot be construed as notice of foreign filing.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(a)(7). Accordingly, as authorized, the required \$130 petition fee will be charged to Deposit Account No. 06-1050.

Any inquiries concerning this decision may be directed to Mark Polutta at (703) 308-8122.

This application is being forwarded to Technology Center Art Unit 3629 to await further examination in due course.



Joni Chang
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Notice Regarding Rescission of Nonpublication Request